

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

LEGO Juris A/S vs Muhammad Farooq

Case No. C2019-0005

Also in PDF C2019-0005

1. The Parties

The Complainant is LEGO Juris A/S having its office at Koldingvej 2, 7190 Billund, Denmark. The Complainant has initiated the Complaint vide their authorized representative, Natalie Leroy, CSC Digital Brand Services AB, Drottninggatan 92-94, 111 36 Stockholm, Sweden.

The Respondent's name is Muhammad Farooq with his address at Comsats University, Abbottabad, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is < legobrick.pk >, hereinafter referred to as the Disputed Domain Name. Vide email dated Tuesday 02 July 2019, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is HosterPK, Shahmir Plaza, Comm Area SCH II, Rawalpindi and its Create Date was 2019-03-13 with an Expire Date of 2021-03-13.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant on 12 June 2019. The Complainant completed all formalities relating to the complaint by 15 June 2019.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 2 July 2019 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. DNDRC awaited the submission by the Complainant of the Complaint as per the prescribed forms also available at

www.dndrc.com/downloads. DNDRC sent a reminder to the Respondent on 9 July 2019 by email. The Respondent did not file a Response.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Mr. Malik Muhammad Ehsan as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

Factual Background

The domain name upon which the Complaint is based is <legobrick.pk>.

PKNIC has confirmed via their email dated 02 July 2019 that the Disputed Domain Name has been registered by the Respondent named in the Complaint.

4. Parties Contentions

A. Complainant

The Complainant has submitted:

LEGO Juris A/S (hereinafter referred to as the Complainant), based in Denmark (Annex 7), is the owner of LEGO, and all other trademarks used in connection with the famous LEGO brands of construction toys and other LEGO branded products. The Complainant's licensees are authorized to exploit the Complainant's intellectual property rights, including its trademark rights, in Pakistan and elsewhere. Over the years, the business of making and selling LEGO branded toys has grown remarkably. The Complainant has subsidiaries and branches throughout the world, and LEGO products are sold in more than 130 countries, including in Pakistan.

Moreover, the Complainant is the owner of close to 5,000 domain names containing the term LEGO (Annex 8). It is the strict policy of the Complainant that all domain names taking an unfair commercial advantage of the LEGO trademark should be recovered by the Complainant.

The trademark LEGO is among the best-known trademarks in the world, due in part to decades of extensive advertising, which prominently depicts the LEGO mark on all products, packaging, displays, advertising, and promotional materials. Indeed, the LEGO trademark and brand have been recognized as being famous. For instance, attached hereto as Annex 9.1, is a list of the official Top 20 Consumer Superbrands for 2018, provided by Superbrands UK, showing LEGO as number 1 Consumer Superbrand and the winner in

the category “Child Products - Toys and Education”. Moreover, the Reputation Institute nominated the LEGO Group as number 2 on both their lists of world’s most reputable companies i.e. “2018 Global RepTrak® Top 10 Companies” and “2018 Global RepTrak® 100”, see Annex 9.2. In 2014, TIME also announced LEGO to be the Most Influential Toy of All Time, see Annex 9.3.

The LEGO Group has expanded its use of the LEGO trademark to, inter alia, computer hardware and software, books, videos and computer controlled robotic construction sets. The LEGO Group also maintains an extensive website under the domain name LEGO.com (Annex 10).

As shown, the mark LEGO is in possession of substantial inherent and acquired distinctiveness. The awareness of the trademark LEGO is considered in the whole Community to be significant. According to the provisions of Article 6bis of the Paris Convention for protection of Industrial Property (“PC”), confirmed and extended by Article 16.2 and Article 16.3 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”), the statute of a well-known trademark provides the owner of such a trademark with the right to prevent any use of the well-known trademark or a confusingly similar denomination in connection with any products or services (i.e. regardless of the list of the products and services for which the trademark is registered). Thus, the protection for LEGO goes far beyond toys and goods similar to toys

The Complainant seeks the following remedy:

Complaint requests a decision to be issued so that the disputed domain name be transferred to Complainant. (UDRP Rule 3(b)(x): UDRP policy 4(i).

B. Respondent

The Respondent has not submitted any response to DNDRC.

Under section 5(e) of the UDRP, in the absence of a response, the Panel has the authority to commence the proceedings in default and to determine the matter based upon the Complaint.

5. Jurisdiction

The Panel’s jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2

and the Rules.

The Respondent applied for and was granted registration of the Disputed Domain Name on the basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf), the Panel laid down the following four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

The decision of the dispute shall be addressed with respect to the following aspects:

- i. *Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 criteria).*
- ii. *Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).*
- iii. *Legitimate interest in the domain name (a UDRP criteria).*
- iv. *Registration and use of the domain name in bad faith (a UDRP criteria).*

I. Illegality, unlawfulness or otherwise invalidity of the Application & Registration

The PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 states that it creates an exception for, and thus excludes the registration of a domain name that:

- a. *infringes upon a registered tradename,*

- b. *is not bona fide as recognized by international best practice,*
- c. *in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. *has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*
- e. *in the opinion of PKNIC is not appropriate for registration.*

As per the PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2,

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, PKNIC reserves the right to cancel, or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

- i. Whether the Disputed Domain Name infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravenes the Pakistan Penal Code, 1860 (the “Penal Code”) or any applicable criminal law?

The Panel will deal with each of these sub-issues sequentially below.

- i. Whether the Disputed Domain Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The Complainant has stated:

By virtue of its trademark registrations as shown in Annexes 6.1 and 6.2, Complainant is the owner of the trademark LEGO. This registered trademark has been incorporated in its entirety in the Domain Name and is an obvious derivation of the same. As such, the Domain Name infringes upon the trademark registrations of the word LEGO that are held by Complainant – an adequate ground for the transfer of the Domain Name to Complainant. As per paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 (PKNIC Policy), if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name, the registration would be deemed illegal and unlawful and for all purposes invalid.

On the other hand, the Respondent has not provided any information whatsoever with respect to the Disputed Domain Names and as such, no data is available to the Panel to consider on the part of the Respondent.

The Panel has reviewed the information submitted by the Complainant to support the Complainant's position that it has registered the mark "LEGO" in Pakistan. The Panel finds that the Disputed Domain Name is a clear derivation of the mark in which the Complainant enjoys rights, and that the application and registration of the Disputed Domain Name by the Respondent appears to be illegal under the Pakistani legislations cited in the Complaint. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

ii. Whether the application and/or registration of Disputed Domain Name is bona fide?

The Complaint has submitted:

The trademark LEGO belonging to the Complainant has the status of a well-known and reputed trademark with a substantial and widespread reputation throughout the whole Community and throughout the world. The awareness of the trademark LEGO is considered to be significant and substantial. The number of third party domain name registrations comprising the trademark LEGO in combination with other words has always been attractive to domain name infringers (as an indication, please see UDRP cases filed in 2018 alone: D2018-2602, D2018-2504, D2018-2519, D2018-2901, D2018-2717, D2018-1929, D2018-1791, D2018-1968, D2018-1924, D2018-1931, D2018-1863, D2018-1779, D2018-1783, D2018-1676, D2018-1570, D2018-1703, D2018-1030, D2018-0987, D2018-0978, D2018-0733, D2018-0978, D2018-0733, D2018-0520,

D2018-0313, D2018-0435, D2018-0097, D2018-0032, D2018-0030). The considerable value and goodwill of the trademark LEGO is most likely, a large contribution to this and also what made the Respondent register the Domain Name at issue here.

The Respondent registered the Domain Name on March 13, 2019 (Annex 2). This date is subsequent to when the Complainant registered the trademark LEGO in Pakistan where the Respondent resides, and elsewhere, by decades (Annexes 6.1 and 6.2). It is quite obvious that it is the fame of the trademark that has motivated the Respondent to register the Domain Name. That is, the Respondent cannot claim to have registered the Domain Name, without being aware of the Complainant's rights to the trademark LEGO. Such is indicative proof that Respondent registration of the Domain Name lacks bona fide.

Once again, the Respondent failed to provide a response to the Complainant's contentions.

The Respondent has resorted to the use in part of a recognized trademark that has been registered in Pakistan since 1979. The Complainant has provided detailed information on the well-known nature of the Complainant's mark, and has indicated the considerable value and goodwill of the mark. Given the fame of the Mark, the Panel finds that it is unlikely that the Respondent was unaware of the Complainant's mark at the time of registration of the Disputed Domain Name in 2019. Hence, the Panel finds that the registration of the Disputed Domain Name is not bona fide.

iii. Whether the application and/or registration of the Disputed Domain Name contravene the Penal Code or any applicable criminal law?

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, by operation of the PKNIC- Internet Domain Registration Policy Aug 07, 2007 version 4.2, it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*.

Trade Marks Ordinance, 2001

40. Infringement of registered trade mark.-

(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of

the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.

4. Domain name not to be misleading as to character or significance.- (1) A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.

Electronic Transactions Ordinance, 2002 (“ETO”)

3. Legal recognition of electronic forms.—

No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”

Penal Code

478. Trade mark.

A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)

Upon a study of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code, the Panel is of the view that the infringement of Trade Marks and Trade Names have been equated with domain names under Pakistani law. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to apply to domain names.

Moreover, according to Section 3 of the ETO, all material, instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract the provisions of the same sections of the Penal Code or any other applicable law had the material been in physical, written or in printed form. The Penal Code, therefore, by the operation of Section 3 of ETO, equally applies to transactions, publications or materials including the use of any trade mark or trade name made available in any electronic form on the internet through the use of a domain name.

By continuing the registration of the Disputed Domain Name by a person who is other than the owner, holder or authorized user of the trade mark or trade name, the registrant would be an aider, abettor, encourager and co-conspirator and also liable to criminal offences.

479. Property mark.

A mark used for denoting that movable property belongs to a particular person is called a property mark.

480. Using a false trade mark.

Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

As such, if a person other than the owner, rightful holder or authorized user of the trade mark or trade name uses the Disputed Domain Name, if possibly linked to any service or goods, it may constitute an offence under the Penal Code.

481. Using a false property mark.

Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.

482. Punishment for using a false trade-mark or property mark.

Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.

As decided in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may also constitute an offence under the Penal Code.

The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name may attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights

The Complainant has contended the following:

The dominant part of the Domain Name comprises the term LEGO, identical to the registered trademark LEGO, registered by the Complainant as trademarks and domain names in numerous countries all over the world (Annexes 6.1, 6.2 and 8).

The Domain Name is confusingly similar to the Complainant's trademark LEGO. The fame of the trademark has been confirmed in numerous previous UDRP decisions: Case no. D2008-1692 LEGO Juris A/S v. Level 5 Corp: "The Panel finds that the Complainant has established that LEGO and LEGOLAND are well-recognized and world famous trademarks and that the trademarks are distinctive", Case no. D2008-1715 LEGO Juris A/S v. Michael Longo: "The Panel finds, as numerous panels have found before, that the Complainant has established that LEGO is a well-known trademark and that the trademark is distinctive and famous", and Case no. D2009-0680 LEGO Juris A/S v. Reginald Hastings Jr: "LEGO is a mark enjoying high reputation as construction toys popular with children".

In addition to the trademark LEGO, the Domain Name also comprises the suffix "brick", which enhances the risk of confusion because it describes Complainant's toy brick products. In Case no. D2019-0555 LEGO Juris A/S v. Dmitry Shelkovnikov, the Panel found the domain name <legobricks.site> to be confusingly similar to the LEGO trademark: "The "lego" element is identical to the LEGO trademark, while the "bricks" element is descriptive of the main product sold under the LEGO trademark. The addition of the term "bricks" does not prevent a finding of confusing similarity."

The addition of the country code top-level domains (ccTLD) ".PK" does not have any impact on the overall impression of the dominant portion of the Domain Name and is therefore irrelevant to determine the confusing similarity between the trademark and the Domain Name.

Anyone who sees the Domain Name is bound to mistake it for a name related to the Complainant. The likelihood of confusion includes an obvious association with the trademark of the Complainant. With reference to the reputation of the trademark LEGO there is a considerable risk that the trade public will perceive the Respondent's Domain

Name either as a domain name owned by the Complainant, or that there is some kind of commercial relation with the Complainant. By using the trademark as a dominant part of the Domain Name, the Respondent exploits the goodwill and the image of the Complainant's trademark, which may result in dilution and other damage for the trademark.

Summarizing this, the Complainant is the owner of the very well-known trademark LEGO. The Domain Name in question is clearly confusingly similar to said trademark

On the other hand, the Respondent has not provided any information in response to the Complainant's contentions.

Based upon the information provided by the Complainant, the Panel finds that the Complainant has rights in the mark "LEGO" based upon trademark registrations in Pakistan and other jurisdictions. The Panel also agrees with the submission of the Complainant that the addition of the word "brick" does not sufficiently distinguish the Disputed Domain Name from the mark of the Complainant, but rather adds to the confusion as it describes the main product sold by the Complainant using the LEGO mark. Moreover, the addition of a ccTLD in the Disputed Domain Name in the Panel's view does not sufficiently distinguish the Disputed Domain Name from the mark of the Complainant. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the mark of the Complainant.

III. Legitimate interests in a domain name

As per paragraph 4(c), the UDRP requires the Respondent's claim to be of legitimate interest and shall be:

"proved based on all evidence presented" that "shall demonstrate" the Respondent's "rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii)."

Paragraph 4(a)(ii) states that:

"(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Complainant has contended:

The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Name. Neither has the Complainant found anything, including the whois details, that would suggest that the Respondent has been using LEGO in any other way that would give them any legitimate rights in the name. Consequently, the Respondent may not claim any rights established by common usage.

No license or authorization of any other kind, has been given by the Complainant to the Respondent, to use the trademark LEGO. In Case no. D2000-0055 Guerlain S.A. v. Peikang the panel stated that: "in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent." Further, the Respondent is not an authorized dealer of the Complainant's products and has never had a business relationship with the Complainant. This was stated by the panel as a factor in the finding of non-legitimate interest with the Respondent in Case no. D2004-0312 Dr. Ing. h.c. F. Porsche AG v. Ron Anderson. Nevertheless, there is no disclaimer on the website to explain the lack of relationship to the Complainant.

LEGO is a famous trademark worldwide and in Case no. D2001-1314, Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc. it was established that any use of such a trademark in a domain name would violate the rights of the trademark owner. The panel stated that: "given the notoriety of the Complainant's Deutsche Bank Mark, any use which the Respondent would make of any domain name, as here, that incorporated the Complainant's Deutsche Bank Mark, or one confusingly similar thereto, would likely violate the exclusive trademark rights which the Complainant has long held in its mark."

The Respondent is not using the Domain Name in connection with a bona fide offering of goods or services. Instead, the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic and income through a commercial website offering bricks for house and building construction, or products not related to the Complainant in any way (Annex 3).

As no evidence has been found that the Respondent is using the name LEGO as a company name or has any other legal rights in the name, it is quite clear that the Respondent is simply trying to sponge off the Complainant's world famous trademark. In Case no. D2001-0067 Drexel University v. David Brouda, the Panel stated that "rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant."

Based on the foregoing, the Respondent has no rights or legitimate interest in respect of the Domain Name.

On the other hand, the Respondent has failed to provide any information in support of the contention that the Respondent has a legitimate interest in the Disputed Domain Name.

The Complainant has stated that the Respondent was not authorized or licensed to use the Complainant's mark LEGO in the Disputed Domain Name or on the website to which the Disputed Domain Name resolves. The Respondent has not provided any information that would support a position that the Respondent is otherwise known by the name LEGOBRICK. Thus, the Panel finds that the Respondent does not have a legitimate interest in the Disputed Domain Name.

IV. Registration and use in bad faith

The Complainant has made the following submission:

The Domain Name was registered years after the Complainant registered the trademark LEGO. This together with the worldwide reputation of the trademark LEGO indicates that the Respondent knew about the Complainant's rights when registering the Domain Name. Stated differently, LEGO is so closely linked and associated with Complainant that Respondent's use of this mark, or any minor variation of it, strongly implies bad faith – where a domain name is "so obviously connected with such a well-known name and products; its very use by someone with no connection with the products suggests opportunistic bad faith." See Case no. D2000-0226 Parfums Christian Dior v. Javier Garcia Quintas. Thus, where the Domain Name fully incorporates the trademark LEGO in combination with the element "brick" which is descriptive of the product for which the trademark LEGO has become well-known, "it defies common sense to believe that Respondent coincidentally selected the precise domain without any knowledge of

Complainant and its trademarks.” See Case no. D2007-1415 Asian World of Martial Arts Inc. v. Texas International Property Associates.

The Complainant first tried to contact the Respondent on April 9, 2019, through a cease and desist letter sent by e-mail with the assistance of the registry (Annex 11). The Complainant advised the Respondent that the unauthorized use of the LEGO trademark within the Domain Name and requested a voluntary transfer of the same.

The Complainant also offered compensation for the expenses of registration and transfer fees (not exceeding out of pocket expenses). Despite that reminders were being sent, no reply was ever received (Annex 12). Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the PKNIC Policy.

It has been mentioned in earlier disputes that the failure of a respondent to respond to a cease and desist letter, or a similar attempt at contact, has been considered relevant in a finding of bad faith, Case no. D2000-1623 News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, Case no. D2000-1598 Nike, Inc. v. Azumano Travel and Case no. D2000-1460 America Online, Inc. v. Antonio R. Diaz.

Moreover, in Case no. D2009-0273 Intel Corporation v. The Pentium Group, the Panel stated that, “[t]he incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith”. See also Case no. D2000-0163 Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.; Case no. D2001-0087 General Electric Company v. CPIC NET and Hussain Syed; Case no. D2000-1568 Microsoft Corporation v. Montrose Corporation.

The Respondent on the other hand has not provided any information in support of the contention that the Disputed Domain Name has been registered or is being used in bad faith.

The Panel has considered the Complainant’s contention that the Disputed Domain Name was registered decades after the Complainant registered the LEGO mark in Pakistan and in other jurisdictions. The worldwide reputation of the Complainant’s mark would mean that the use of this mark by the Respondent, even with a minor variation, would imply the existence of bad faith. The failure of the Respondent to reply to the Complainant’s correspondences may also be seen to indicate bad faith.

Thus, the Panel concludes based on the information before it that the Disputed Domain Name was registered and is being used in bad faith.

7. Decision

Analyzing the details provided by the Complainant, the Panel perceives that the LEGOBRICK mark has been registered by the Complainant, hence the Complainant reserves crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining and result in confusion as to the registrant of the Disputed Domain Name.

Taking all of the case law and discussion above into consideration, the Panel concludes and decides that:

1. The Respondent's registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
4. The Disputed Domain Name was registered and being used in bad faith.

Pursuant to Section 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Section 4(i) of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute < legobrick.pk> to the Complainant, as prayed within 48 hours of receipt of this decision by email or its being uploaded on to DNDRC's website www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Mr. Malik Muhammad Ehsan

Sole Panelist

Date: 19 August 2019